



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE MATTER OF:

HITOMI, et al.

GROUP: 1644

SERIAL NO.: 09/910,028

EXAMINER: HADDAD, M. M.

FILED: JULY 20, 2001

FOR: NOVEL CALCIUM-BINDING PROTEINS

ELECTION AND REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the outstanding Office Communication dated October 5, 2004 in the form of a Restriction Requirement. Applicants additionally request a one-month Extension of Time, to be deducted from Deposit Account Number 01-1944. Sequence listings for SEQ ID NOS: 2-11 and 13- 18 have been directed to Box Sequence, as requested by the Examiner.

Applicants elect Group IV, inclusive of claims 18-23, drawn to an antibody with binding affinity to a protein encoded by SEQ ID NO:1 or 12 and a method for producing, classified in class 530, subclass 387.3 and 391.1; class 424, subclass 133.1; and class 435, subclass 810. Additionally, Applicants elect the species SEQ ID NO: 12, human calcium-binding protein.

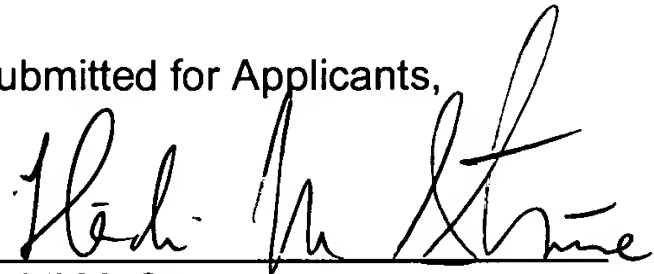
Applicants additionally wish to request that the Examiner reconsider the placement of claim 24 in a separate group from claims 18-23. The previous Examiner had placed this claim in a group with claims 18-23 and Applicants respectfully traverse the Examiner's decision to separate them. Alternatively, the Applicants would traverse the restriction as it applies to Groups IV and V on the basis that there is no undue burden on the Examiner.

The MPEP at §808.02 suggests that several criteria are to be weighed in assessing what is and is not an undue burden. For the purposes of the instant claims,

the Examiner is arguing that the most relevant of these is **C) A different field of search**. The two groups IV and V were placed in different classes and subclasses. However, a quick perusal of related art shows patents with claims to both antibodies and assay methods using such antibodies, which are in many of the same classes and subclasses as the claims in Groups IV and V, suggesting that it would not be an undue burden for the Examiner to examine all of the claims therein. For example, the Examiner's attention is directed to US Patent Nos. 6,794,494; 6,790,625; 6,777,194; and 6,723,317, all of which represent patents directed to which contain both product (antibody) claims and claims directed to the process of using said product. Accordingly, Applicants respectfully request either rejoinder of claim 24 in a group with claims 18-23, or that all claims in Groups IV and V be examined.

Early examination and allowance of the pending claims is respectfully solicited.

Submitted for Applicants,

A handwritten signature in black ink, appearing to read "Heidi M. Struse", written over a horizontal line.

Heidi M. Struse

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 3, 2004.

A handwritten signature in black ink, appearing to be "Maggie McGarry", written over a horizontal line.

Maggie McGarry